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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,514	08/22/2003	William C. Neubauer	28363/36886A	9661

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EXAMINER

DURAND, PAUL R

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,514

Applicant(s)

NEUBAUER ET AL.

Examiner

Paul Durand

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-57 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 48-57 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 48-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vijuk et al (US 6,068,300) in view of Glans et al (US 4,606,784) and in further view of Vijuk (US 4,812,195).

Vijuk '300 discloses the invention substantially as claimed including forming a first folded article comprised of a sheet 51, with multiple parallel folds, forming a second article by folding the first article in a perpendicular or transverse direction, forming a third article by folding the second article in a direction parallel to the second fold direction, applying adhesive to the article and creating a final fold parallel to the second folding direction so that adhesive holds the outsert in a closed position (see Fig.4 and C5,L55 – C7,L38). What Vijuk '300 does not disclose is the use of a pressure roller or the folding device makeup. However, Glans teaches that it is old and well known in the art of folding to provide pressure rollers 11 mounted to housing 10, for the purpose of maintaining the article in a flat condition prior to a folding operation (see Fig. 1 and C2,L14-27). Furthermore, Vijuk '195 teaches that it is old and well known in the art to provide a folding machine with a movable blade 49 to push the sheet into a plurality of

Art Unit: 3721

folding roller 250 and 251, with a nip in between for the purpose of ensuring that an outsert feeds correctly into a folding roller (see Fig. 26A, 26C, C4,L14-32). Therefore, it would have been obvious to one having ordinary skill in the art to have modified the invention of Vijuk '300 with the pressure roller of Glans and the folding specifics of Vijuk '195 for the purpose of manufacturing a folded outsert.

In regard to the pressure range of the rollers, Glans et al discloses the pressure roller invention, which subjects the folded material to a "powerful pressure". What Glans does not disclose is the pressure range of 30-500 psi. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a pressure range, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involve only routine skill in the art. In re Aller, 105 USPQ 233.

In regard to claims 49 and 50, Vijuk '300 discloses the invention substantially as claimed including making a plurality of folds in a second direction, making at least one additional fold to form a second article (see Fig.4)

In regard to claims 51 and 52, the modified invention of Vijuk '300 discloses the invention substantially as claimed including Vijuk '195 teaches that it is old and well known in the art to provide a folding machine with a conveying system to move the sheet through the various folding processes for the purpose of folding an outsert (see Fig. 26A, 26C, C4,L14-32).

3. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vijuk '300 in view of Glans et al, in further view of Vijuk '195 and in further view of Lehmann (US 6,475,129).

In regard to claim 53, Vijuk '300 discloses the invention substantially as claimed including forming a first folded article comprised of a sheet 51, with multiple parallel folds, forming a second article by folding the first article in a perpendicular or transverse direction, forming a third article by folding the second article in a direction parallel to the second fold direction, applying adhesive to the article and creating a final fold parallel to the second folding direction so that adhesive holds the outsert in a closed position (see Fig.4 and C5,L55 – C7,L38). What Vijuk '300 does not disclose is the use of a pressure roller or the folding device makeup. However, Glans teaches that it is old and well known in the art of folding to provide pressure rollers 11 mounted to housing 10, for the purpose of maintaining the article in a flat condition prior to a folding operation (see Fig. 1 and C2,L14-27). Furthermore, Vijuk '195 teaches that it is old and well known in the art to provide a folding machine with a movable blade 49 to push the sheet into a plurality of folding roller 250 and 251, with a nip in between for the purpose of ensuring that an outsert feeds correctly into a folding roller (see Fig. 26A, 26C, C4,L14-32). Still furthermore, Lehmann teaches that it is old and well known in the art of folding to provide a folding station with plural folding rollers W1-W5 and nips F1-F4 for the purpose of making plural parallel folds (see Figs. 1,2 and C3,L46-59). Therefore, it would have been obvious to one having ordinary skill in the art to have modified the

invention of Vijuk '300 with the pressure roller of Glans and the folding specifics of Vijuk '195 for the purpose of manufacturing a folded outsert.

In regard to the pressure range of the rollers, Glans et al discloses the pressure roller invention, which subjects the folded material to a "powerful pressure". What Glans does not disclose is the pressure range of 30-500 psi. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a pressure range, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involve only routine skill in the art. In re Aller, 105 USPQ 233.

4. Claims 54-57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vijuk '300, Glans et al, Vijuk '195 and Lehmann as applied to claim 53 and in further view of Rosenbaum et al (US 4,527,319).

The modified invention of Vijuk '300 discloses the invention substantially as claimed except for the specific adjusting means for the pressure rollers. However, Rosenbaum, teaches that it is old and well known in the art to have a stationary pressure rollers 302 and a movable pressure roller 306, with an adjustment device 318 and a plurality of stacked spring washers for the purpose of varying the pressure applied to an object (see Fig.7 and C10,L13-26). Therefore, it would have been obvious to one having ordinary skill in the art to have modified the modified invention of Vijuk '300 with the pressure roller of Rosenbaum or the purpose of varying the pressure applied to an object.

Response to Arguments

5. Applicant's arguments filed 4/1/2005 have been fully considered but they are not persuasive.

Applicant first argues that Vijuk '195 does not disclose an invention, which utilizes bi-directional folding. First, the examiner asserts that there is some confusion regarding the applicant's use of the term bi-directional. The examiner cannot find any support in the specification for the use of the term bi-directional. Second, if applicant is referring to the use of some sort of zig-zag folding, the examiner would argue that the use of multiple rollers to perform zig-zag folding is well known in the art, and if included into the claims, the examiner would provide the appropriate references to show applicant the state of the prior art. Lastly, the examiner asserts that the limitation of bi-directional is not claimed in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues that the blade show is used to make a certain fold in the folding operation. The examiner does agree that Vijuk '195 shows a particular folding operation, Vijuk is also being provided to show applicant that it is well known to provide a folding blade to assist in the folding of material at any point in the operation. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references

Art Unit: 3721

themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Moreover, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Further, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further argues that the teaching of Glans is non-analogous art. The examiner does not agree and asserts that Glans addresses a problem that applicant is trying to solve. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the examiner asserts that the teaching of Glans like the applicant is using pressure rollers for the purpose of ensuring a folded item will stay in a set position.

Therefore, for the reasons indicated above, the rejection is deemed proper.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

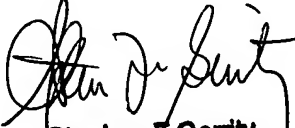
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand
June 14, 2005


Stephen F. Gerrity
Primary Examiner
571-272-4460